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3M INNOVATIVE PROPERTIES COMPANY  
PO BOX 33427  
ST. PAUL, MN 55133-3427

EXAMINER

BANGACHON, WILLIAM L

ART UNIT	PAPER NUMBER
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2635

DATE MAILED: 03/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/755,714

Applicant(s)

BERQUIST ET AL.

Examiner

William Bangachon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19, 22-27 and 31-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19, 22-27 and 31-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11.13
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

1. The objection to the drawings under 37 CFR 1.83(a) is withdrawn.

### *Specification*

2. The objection to the disclosure (page 3, line 4, page 9, line 3) containing an embedded hyperlink and/or other form of browser-executable code is withdrawn.

The objection to the specification as failing to provide proper antecedent basis for the claimed subject matter is withdrawn.

### *Response to Arguments*

3. Applicant's arguments filed 12/15/03 have been fully considered but they are not persuasive.

Applicant refers to an affidavit or declaration filed in the parent application (page 13, 4<sup>th</sup> paragraph; paragraph bridging pages 14 and 15). Affidavits or declarations, such as those submitted under 37 CFR 1.131 and 37 CFR 1.132, filed during the prosecution of the parent application **do not automatically become a part of this application**. Where it is desired to rely on an earlier filed affidavit or declaration, the

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applicant should make the remarks of record in the later application and include a copy of the original affidavit or declaration filed in the parent application.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "the contents of allowed copending US application 09/368,826" (paragraph bridging pages 14 and 15; "term graphic is defined in the specification which is a visual depiction of information composed primarily of non-characters" (page 16, 2<sup>nd</sup> paragraph); "a graphic representation of a book shelf is a longitudinal bar graph" (paragraph bridging pages 17 and 18)) are not recited in the rejected claim(s). **Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.** See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In this case, the claims are broader than what applicant argues. i.e. it is unclear how the elements in the claims form a cooperative relationship and is interpreted as separate, independent elements.

The examiner respectfully traverse applicant's arguments that the Rupert et al reference does not disclose "a user interface in which at least *one graphic associated with the item of interest* may be presented on the display for observation by a user" (page 16, 2<sup>nd</sup> and 3<sup>rd</sup> paragraphs; page 17, last paragraph). It is noted that the definition of "graphic" as argued by the applicant, "term graphic is defined in the specification as a visual depiction of information composed primarily of non-characters"

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(page 16, 2<sup>nd</sup> paragraph)) is not recited in the rejected claims. Therefore, as shown in figures 1 and 13 of the Rupert et al reference, graphics is clearly depicted in the form of a shopping list. And as taught by Rupert et al, "the product ID may be used to alter the display of a shopping list to show that item as checked off" {col. 32, lines 14-20} which is analogous to the claimed "*one graphic associated with the item of interest may be presented on the display for observation by a user*".

In response to applicant's arguments (page 18, last paragraph) that the method of programming an RFID reader does not apply to the apparatus of claims 1-16, it is unclear whether applicant has several inventions in the application not disclosed in the specification (i.e. additional inventions are only disclosed in claims 34-38).

For the above reasons, the rejection to claims 1-19, 22-27, and 31-38, is maintained in this Office action.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5. Claims 1, 17, 22-24, and 31, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The RFID interrogation source, antenna, processor, and display of claims 1, 17, 20, 22-24, 28, and 30-31 lacks structural relationship/cooperation with the other elements in the claims. It is unclear and confusing how these elements form a portable RFID reader for use in interrogating RFID tags. It is noted that **although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.** See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

6. Claims 34-38 provides for the use of an RFID reader for interrogating RFID tags, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 34-38 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 1-6, 28-30, 34-38 rejected under 35 U.S.C. 102(b) as being anticipated by US 5,640,002 (Ruppert et al).

In claims 1, 2, 28-29, and 30, Ruppert et al teach of a portable RFID reader (314) for use in interrogating RFID tags (figure 20) associated with items of interest, comprising:

- (a) an RFID interrogation source {col. 22, lines 59-65; col. 23, lines 6-10; col. 44, lines 63-67};
- (b) an antenna (304, 307, 440) {col. 23, lines 10};
- (c) a processor (320);
- (d) a display (figures 1 and 13; figures 16 and 19: 308, 328); and



(e) a user interface (328, 308A, 308B) in which at least one graphic associated with the item of interest (such as a grocery list) may be presented on the display for observation by a user as shown in figures 1 and 13 {col. 30, lines 4-32; col. 32, lines 9-20; col. 39, lines 29-40}.

In claim 3, the graphic is representative of an area interrogated by the RFID reader {col. 39, lines 50-56, lines 50-57}.

In claim 4, the processor and display are components of a hand-held computer (320) {col. 17, lines 29-36}.

In claim 5, the display may be activated by touch {paragraph bridging cols. 17 and 18}.

In claim 6, the user interface further includes text associated with the item of interest may be presented on the display for observation by a user as shown in figures 1 and 13 {col. 30, lines 4-32}.

Claims 34-38 recites a method of programming the apparatus of claims 1-16 and therefore rejected for the same reasons.

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12. Claims 7-17, 24-25, and 28-30, are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,640,002 (Ruppert et al).

In claim 7, Rupert et al does not disclose expressly **“at least one audio signal for providing information to the user related to an interrogated RFID tag”**. Rupert et al teach of mixed shopping for products with both barcodes and RFID tags. When a shopper picks a product off the shelf, the product ID is input in the system either by scanning or interrogation {col. 32, lines 9-20}. If there is a good reading on the scanned product, a audible indication is performed {col. 27, lines 60-64}. Obviously, a visible or audible indication is also performed on an interrogated RFID tag because whether a product is scanned or interrogated, the ID of the product is the input to the system, to one of ordinary skill in the art.

In claim 8, “the audio signal is provided each time an RFID tag is interrogated” whether it is a bad read or a good read {col. 27, lines 60-64}.

In claim 9, the portable RFID reader of claim 7, wherein the audio signal is only provided when the RFID tag of an item meeting a predetermined criterion is interrogated {col. 27, lines 60-64}. In this case, a successful decoding operation was performed.

In claims 10 and 28-30, the portable RFID reader of claim 9, wherein the predetermined criterion is selected from a group consisting of

- (a) a specific RFID tag associated with an item of interest {col. 22, lines 59-65};
- (b) an RFID tag that is out of order relative to the RFID tag of at least one adjacent item; and
- (c) a class of items to which the item of interest belongs.

In claim 11, the portable RFID reader of claim 10, wherein the criterion in response to which the audio signal is provided may be presented on the display for observation by a user {col. 32, lines 17-20}.

In claim 12, although Rupert et al does not disclose expressly "at least one light for providing information to the user", Rupert et al teach that if there is a good reading on the scanned product, a visible indication is performed {col. 27, lines 60-64}. A light, such as a led, would obviously be a visible indicator, to one of ordinary skill in the art.

In claim 13, clearly, there has to be at least one light that is illuminated each time an RFID tag is interrogated, as a visible indicator {col. 27, lines 60-64}.

In claim 14, the portable RFID reader of claim 12, wherein the light is only illuminated when the RFID tag of an item meeting a predetermined criterion is interrogated {col. 27, lines 60-64}. In this case, a successful decoding operation was performed.

In claims 15 and 28-30, the portable RFID reader of claim 14, wherein the predetermined criterion is selected from a group consisting of

- (a) a specific RFID tag associated with an item of interest {col. 22, lines 59-65};
- (b) an RFID tag that is out of order relative to the RFID tag of at least one adjacent item; and
- (c) a class of items to which the item of interest belongs.

In claim 16, the portable RFID reader of claim 15, wherein the criterion in response to which the at least one light is illuminated may be presented on the display for observation by a user {col. 32, lines 17-20}.

Claim 17 recites the combination of claims 1-3 and therefore rejected for the same reasons.

Claim 22 recites the combination of claims 1 and 7-11 and therefore rejected for the same reasons.

Claims 24-25 recites the combination of claims 1 and 13-14 and therefore rejected for the same reasons.

13. Claims 18-21 and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,640,002 (Ruppert et al) in view of US 6,318,636 (Reynolds et al).

In claims 20-21, although Ruppert teaches of generating audible indication of a bad read and a good read {Ruppert, col. 27, lines 60-64}, Ruppert does not disclose expressly "a first and second audio signals that differ from each other in at least one of frequency, duration, and number of repetitions". Obviously, the audible indication has to differentiate a bad read from a good read, otherwise, a user of the system of Ruppert cannot tell whether the product scanned was saved.

Reynolds et al teach of a first and second audio signal indicator that differs in the number of repetitions, to indicate a bad read from a good read {Reynolds, figure 5A, col. 35; figure 14, 700; col. 8, lines 1-10} for the purpose of providing an intuitive output {Reynolds, col. 2, lines 48-50}. Clearly, these features are desirable in the system of Ruppert to indicate a bad read from a bad read. The systems of Ruppert and Reynolds are analogous art because they are from same field of endeavor, RFID reader systems. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to have used a first and second audio signal indicator that differs in the number of repetitions, in the system of Ruppert, as taught by Reynolds, because this will distinguish a bad read from a good read.

In claims 26-27, although Ruppert teach of generating visible indication of a bad read and a good read {Ruppert, col. 27, lines 60-64}, Ruppert does not disclose expressly "a plurality of lights indicating different occurrences". Obviously, the visible indication has to differentiate a bad read from a good read, otherwise, a user of the system of Ruppert cannot tell whether the product scanned was saved.

Reynolds et al teach of a first and second audio signal indicator that differs in the number of repetitions, to indicate a bad read from a good read {Reynolds, figure 5A, col. 33; figure 14, 700; col. 7, lines 25-65} for the purpose of providing an intuitive output {Reynolds, col. 2, lines 48-50; col. 9, lines 21-33}. Clearly, these features are desirable in the system of Ruppert to indicate a bad read from a bad read. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to have used a plurality of lights indicating different occurrences, in the system of Ruppert, as taught by Reynolds, because this will distinguish a bad read from a good read.

Claims 18-19 are similar to claims 20-21 and 26-27 except claims 18 and 19 used the display graphics to indicate the location of an item of interest wherein claim 18 uses bars and claim 19 uses icons. Reynolds et al teach of using the display graphics to indicate a bad read from a good read {figures 6 and 7; col. 8, line 63-col. 9, line 20} for the purpose of providing an intuitive output {Reynolds, col. 2, lines 48-50; col. 9, lines 21-33}. Clearly, these features are desirable in the system of Ruppert to indicate a bad read from a bad read. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to have used the display graphics to

indicate the location of an item of interest wherein claim 18 uses bars and claim 19 uses icons, in the system of Ruppert, as taught by Reynolds, because this will distinguish a bad read from a good read.

14. Claims 1-2, 28-30, 34-38 ejected under 35 U.S.C. 102(e) as being anticipated by US 6,318,636 (Reynolds et al).

In claims 1, 2, 28-29, and 30, Reynolds et al teach of a portable RFID reader (10) for use in interrogating RFID tags (12) associated with items of interest, comprising:

(a) an RFID interrogation source {col. 22, lines 59-65; col. 23, lines 6-10; col. 44, lines 63-67};

(b) an antenna (42);

(c) a processor (46);

(d) a display (74); and

(e) a user interface {col. 7, lines 43-67} in which at least one graphic associated with the item of interest may be presented on the display for observation by a user as shown in figures 6 and 7.

(f) an RFID interrogation source as claimed in claims 17, 20, 22-24, 28, and 30-31 {col. 6, lines 57-61}.

It is noted that **although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.** See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claims 34-38 recites a method of programming the apparatus of claim 1 and therefore rejected for the same reasons.

***Examiner Contact Information***

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Bangachon whose telephone number is 703-305-2701. The examiner can normally be reached on 4/4/10.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on 703-305-4704. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9314 for regular and After Final formal communications. The examiner's fax number is 703-746-6071 for informal communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

William L Bangachon  
Examiner  
Art Unit 2635

March 1, 2004

MICHAEL HORABIK  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

